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**THIS DISPOSITION
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Paper No. 15
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Global Marketing Associates, Ltd.

Serial No. 75/416,692

Joan Fagan Teich, Esq. of Geltner & Associates, P.C. for
Global Marketing Associates, Ltd.

Karanendra S. Chhina, Trademark Examining Attorney, Law
Office 101 (Jerry Price, Managing Attorney).

Before Hanak, Bottorff and Drost, Administrative Trademark
Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark SUPERINVESTOR, in typed form, for services
recited in the application, as amended, as "financial and
investment consultation services" in International Class
36.¹

¹ Serial No. 75/416,692, filed January 12, 1998. The application
is based on applicant's allegation of a bona fide intention to
use the mark in commerce, under Trademark Act Section 1(b), 15
U.S.C. §1051(b).

The Trademark Examining Attorney has refused registration on the ground that applicant's mark, as applied to the services recited in the application, so resembles the mark THE SUPERINVESTOR FILES, which is registered in typed form for goods identified in the registration as "series of financial and investment reference books,"² as to be likely to cause confusion, to cause mistake, or to deceive. See Trademark Act Section 2(d).

When the refusal was made final, applicant filed a notice of appeal, its appeal brief, and a request for reconsideration. The Trademark Examining Attorney, upon remand from the Board, rejected the request for reconsideration and maintained the final refusal. With the Board's permission, applicant filed a supplemental appeal brief, and the Trademark Examining Attorney then filed an appeal brief. Applicant did not file a reply brief, nor did applicant request an oral hearing.

After careful consideration of the evidence of record and the arguments made by applicant and by the Trademark Examining Attorney, we affirm the refusal to register.

² Registration No. 2,160,280, issued on the Principal Register on May 26, 1998.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We turn first to the issue of whether applicant's mark and registrant's mark, when compared in their entireties in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this

dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

We find that the dominant feature in the commercial impression created by the cited registered mark THE SUPERINVESTOR FILES is the word SUPERINVESTOR. Contrary to applicant's contention, it does not appear from the record that SUPERINVESTOR is a "common stock phrase" in the investment or finance field; no third-party uses or users of the term are in evidence. We accordingly are not persuaded that SUPERINVESTOR is a weak term which is entitled to a relatively narrow scope of protection.

Likewise, we are not persuaded that the presence in the registered mark of the additional words "THE" and "FILES" suffices to distinguish applicant's mark and the registered mark in terms of their overall commercial impressions. The introductory article "THE" contributes very little, if anything, to the commercial impression of the registered mark. "FILES" is somewhat suggestive as applied to the "series of financial and investment reference books" identified in the registration. In this regard, we take judicial notice that "file," the singular form of "files," is defined, *inter alia*, as "a collection of papers or publications usu. arranged or classified."

Webster's Ninth New Collegiate Dictionary (1990) at 462.

As it is used in registrant's mark, FILES is clearly less distinctive and important than the word preceding it, SUPERINVESTOR, which identifies and specifies which "files" are being referred to.

In sum, we find that the dominant feature of registrant's mark is the word SUPERINVESTOR. That word also comprises the entirety of applicant's mark.³ We find that the dissimilarities between the two marks in terms of appearance, sound and meaning, which are caused solely by the presence in the registered mark of the additional words "THE" and "FILES," are outweighed by the overriding similarity between the overall commercial impressions of the two marks, which results from their shared use of the

³ Applicant asserts that its promotional materials will always use the SUPERINVESTOR mark in conjunction with the name of applicant's president, Mark Tier, who allegedly is a noted authority in the field of finance and investments, and that applicant's affiliation with Mr. Tier will always be clearly and explicitly advertised. These measures will be sufficient, applicant argues, to avoid any confusion on the part of reasonable consumers. However, neither Mr. Tier's name nor his affiliation with applicant's services is reflected in the drawing of the mark applicant seeks to register. The fact that applicant might include those pieces of information in its marketing materials is immaterial to our likelihood of confusion determination in this case. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 842 (Fed. Cir. 2000); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, n.4 (Fed. Cir. 1993); *Vornado, Inc. v. Breuer Electric Mfg. Co.*, 156 USPQ 340 CCPA 1968); *Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910 (TTAB 2000); *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212 (TTAB 1990).

word SUPERINVESTOR. The two marks are sufficiently similar that confusion is likely to result if they are used on or in connection with related goods and services.

We turn next to the question of whether applicant's services are sufficiently commercially related to registrant's goods that confusion is likely to result from use of applicant's and registrant's respective marks on or in connection therewith. It is not necessary that the respective goods and services be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association or connection between the producers of the respective goods. *See In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Applicant argues that although registrant's books and applicant's consulting services both pertain to the broad field of finance and investments, they are different and

readily distinguishable in terms of their specific content, format and purpose. According to applicant, registrant's books are a "home-study" guide covering specific investment techniques, while applicant's consulting services involve "individual or group counseling or 'coaching' for clients regarding psychological blocks or behaviors which lead to poor financial and investment decisions." However, our likelihood of confusion determination must be based on the goods and services as they are identified in applicant's application and in the cited registration, not on the basis of what the actual goods and services of the parties might be. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Because the alleged differences in content, format and purpose relied on by applicant are not reflected in the respective identifications of goods and services in the registration and application, they are irrelevant to our likelihood of confusion analysis.

The Trademark Examining Attorney has submitted evidence of twenty-one third-party registrations for marks which cover both financial and investment consulting services, such as those identified in applicant's application, and books and other printed matter in the field of finance and investment, such as those identified

in the cited registration. Although these registrations are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them, they nevertheless are probative evidence to the extent that they suggest that such goods and services are of a type which may emanate from a single source under a single mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 (TTAB 1988). The commercial relationship between the respective goods and services is further evidenced by the declaration of applicant's principal, Mark Tier. He states that in addition to his financial and investment consulting services, he also has been involved in "the investment and financial publication business" for over twenty-four years, and that he is currently writing a book relating to this field.

In light of this evidence, we find that the services recited in applicant's application and the goods identified in the cited registration are sufficiently related that confusion is likely to result from use thereon of the marks SUPERINVESTOR and THE SUPERINVESTOR FILES, respectively.

Applicant argues that its services and registrant's books are marketed in different trade channels to different classes of purchasers. However, neither applicant's nor

registrant's identification of goods and/or services is limited in any way as to trade channels or classes of purchasers, and we accordingly must presume that the respective goods and services may be marketed in all normal trade channels and to all normal classes of purchasers. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

Likewise, there is no evidence in the record from which we can conclude that members of the relevant classes of purchasers are necessarily knowledgeable, sophisticated consumers who are careful when purchasing goods and services involving their finances and investments. As the Trademark Examining Attorney has noted, the respective identifications of goods and services are broad enough to include those which are mass-marketed via television infomercials to the members of the general public. We cannot conclude that the relevant purchasers are necessarily so sophisticated or careful that they would be immune to source confusion arising from use of these confusingly similar marks on these closely related goods and services.

In summary, we have considered all of the evidence of record pertaining to the relevant *du Pont* evidentiary factors, and we conclude that confusion is likely in this case. Purchasers are likely to assume that financial and

investment reference books offered under the mark THE SUPERINVESTOR FILES originate from, are sponsored by, or are otherwise connected to or affiliated with the financial and investment consulting services offered under the SUPERINVESTOR mark, and vice versa. Any doubts as to this conclusion (we have none) must be resolved against applicant. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.